



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

§ Group Art Unit: 2111

§
§ Examiner: Dang, Khanh Nmn

§ Atty. Dkt. No.: 5500-64900
§ TT4212

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below:

Robert C. Kowert
Name of Registered Representative

October 11, 2004
Date

[Signature]
Signature

www

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE
WITH 37 CFR 1.192(c)

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Washington D.C. 20231

Sir/Madam:

In the Notification of Non-Compliance With 37 CFR 1.192(c), the Examiner objects to the “Grouping of Claims” section of Appellants’ Appeal Brief for indicating that each of claims 12, 28 and 39 stands or falls alone. The Examiner states that the limitations of these claims are the same and their respective parent claims stand or fall together. Appellants assert that the Appeal Brief as submitted was fully compliant with the Rules for at least the following reasons.

First, the Examiner appears to simply be disagreeing with Appellants' claim groupings. This is not an issue of compliance with the Rules, but simply an issue that the Examiner should address in his Answer.

Second, the Examiner has withdrawn his rejection of claims 12, 28 and 39. **Therefore, any issue regarding the grouping of these claims is now moot.**

Third, the claims were properly grouped to each stand or fall alone. In the Final Rejection, claims 12 and 39 were rejected under 35 U.S.C. § 112, but claim 28 was not. Therefore, it was proper to group claim 28 separately from claims 12 and 39 because the Board could have found all three claims patentable over the prior art but upheld the § 112 rejection of claims 12 and 39. In this case, claim 28 would not stand or fall with claims 12 and 39 since it was not rejected under § 112. Therefore, it was proper to group claim 12 to stand or fall alone. Furthermore, it was also proper to group claims 12 and 39 separately because they were each rejected under different grounds. Claim 12 was rejected under § 102(e) whereas claim 39 was rejected under § 103(a). The Board could have upheld the § 103(a) rejection of claim 39 under the obvious standard, but not the § 102(e) rejection of claim 12 under the anticipation standard, for example. In this case, claims 12 and 39 would clearly not stand or fall together. Therefore, it was proper to group claims 12 and 39 separately.

In light of the above comments, Appellants assert that the Appeal Brief was in complete compliance with 37 CFR 1.192(c) when submitted. Furthermore, any issue as to the grouping of claims 12, 28 and 39 is moot since the Examiner has withdrawn his rejections of these claims. Since the Examiner has withdrawn his rejection of claims 5-13, 15, 21-29 and 32-39, the "Grouping of Claims" section of the Appeal Brief may be replaced as follows, if necessary.

VII. GROUPING OF CLAIMS

Claims 1, 2, 4, 14, 16-18, 20, 30 and 40 stand or fall together for purposes of this appeal only.

Claims 3, 19 and 31 stand or fall together for purposes of this appeal only.

CONCLUSION

Appellants respectfully request that the appeal be considered by the Board of Patent Appeals and Interferences. Appellants note that the rejection of claims 5-13, 15, 21-29 and 32-39 has been withdrawn. For the reasons presented in the Appeal Brief, it is submitted that the Examiner's rejection of claims 1-4, 14, 16-20, 30, 31 and 40 was erroneous, and reversal of the Examiner's decision is respectfully requested.

No fee or extension of time is believed necessary. However, to the extent any fee or extension of time is necessary, the Commissioner is hereby authorized to charge such fee to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/5500-64900/RCK.

This Response is submitted with the following items:

☒ Return Receipt Postcard

Respectfully submitted,



Robert C. Kowert

Reg. No. 39,255

Attorney for Appellants

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8850

Date: October 11, 2004